

ESTTA Tracking number: **ESTTA575291**Filing date: **12/09/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Whole Foods Market IP, L.P.
Granted to Date of previous extension	12/08/2013
Address	550 Bowie Street 6th Floor Austin, TX 78703 UNITED STATES

Attorney information	Christopher L. Graff Pirkey Barber PLLC 600 Congress Avenue Suite 2120 Austin, TX 78701 UNITED STATES jmatthysse@pirkeybarber.com, cgraff@pirkeybarber.com, ryounger@pirkeybarber.com, drausa@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512-322-5200
----------------------	--

Applicant Information

Application No	85805291	Publication date	06/11/2013
Opposition Filing Date	12/09/2013	Opposition Period Ends	12/08/2013
Applicant	Murdock, Joseph 1242 South Dudley Street Lakewood, CO 80232 USX		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Restaurant services
--


Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1961586	Application Date	10/11/1994
Registration Date	03/12/1996	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS MARKET		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1980/09/30 First Use In Commerce: 1980/09/30 retail grocery store services, in-storerestaurant services, and in-store bakery services specializing in health foods and natural foods

U.S. Registration No.	1557320	Application Date	01/04/1988
Registration Date	09/19/1989	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS MARKET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/09/30 First Use In Commerce: 1980/09/30 RETAIL GROCERY STORE SERVICES, IN-STORERESTAURANT SERVICES, AND IN-STORE BAKERY SERVICES IN HEALTH FOODS AND NATURAL FOODS		

U.S. Registration No.	2473973	Application Date	06/22/1998
Registration Date	07/31/2001	Foreign Priority Date	NONE
Word Mark	WHOLEZYME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1998/06/01 First Use In Commerce: 1998/06/01 Non-Prescription Dietary Supplements		


U.S. Registration No.	3087983	Application Date	05/16/2003
Registration Date	05/02/2006	Foreign Priority	NONE


		Date	
Word Mark	WHOLE BABY		
Design Mark	<p style="text-align: center;">WHOLE BABY</p>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2005/08/00 First Use In Commerce: 2005/09/22 Printed matter and paper products offered through owner's licensed retail grocery stores, namely brochures, pamphlets and printed guides on prenatal, postnatal and early childhood nutrition, health, wellness and body care		

U.S. Registration No.	3104557	Application Date	07/28/2004
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	WHOLE CATCH		
Design Mark	<p style="text-align: center;">WHOLE CATCH</p>		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2004/09/00 First Use In Commerce: 2004/09/00 Prepared, frozen and non-frozen packaged entrees, side dishes, appetizers, and hors d'oeuvres all consisting primarily of fish or seafood		

U.S. Registration No.	3135943	Application Date	02/08/2006
Registration Date	08/29/2006	Foreign Priority Date	NONE
Word Mark	THE WHOLE GROCER		
Design Mark	<p style="text-align: center;">THE WHOLE GROCER</p>		
Description of Mark	NONE		

Goods/Services	Class 035. First use: First Use: 1984/00/00 First Use In Commerce: 1984/00/00 Retail grocery store services; Retail delicatessen services		
----------------	--	--	--

U.S. Registration No.	3674229	Application Date	08/05/2008
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	THE WHOLE DEAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2008/08/00 First Use In Commerce: 2008/08/00 Retail grocery store services, supermarkets; Providing information on-line relating to money saving tips, recipes, menu planners, shopping, and nutrition		

U.S. Registration No.	4158967	Application Date	05/06/2011
Registration Date	06/12/2012	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS WINE & SPIRITS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2011/05/24 First Use In Commerce: 2011/05/24 Retail store services featuring liquor, wine, beer, and beverages		

U.S. Registration No.	3593120	Application Date	01/10/2006
Registration Date	03/17/2009	Foreign Priority Date	NONE
Word Mark	WHOLE TRADE		

Design Mark	WHOLE TRADE
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 2007/11/00 First Use In Commerce: 2007/11/00 Fruit juice

U.S. Registration No.	4053172	Application Date	05/03/2011
Registration Date	11/08/2011	Foreign Priority Date	NONE
Word Mark	WHOLE STORY		
Design Mark	WHOLE STORY		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2008/06/02 First Use In Commerce: 2008/06/02 On-line journals, namely, blogs featuring food and food related content, cooking, recipes, meal planning, food production, health, nutrition, music, philanthropy, social welfare and activism, conservation, ecology, flora, wildlife, aquaculture, and related commentary; entertainment services, namely, providing audio podcasts featuring food and food related content, cooking, recipes, meal planning, food production, health, and nutrition; entertainment services, namely, providing video podcasts featuring food and food related content, cooking, recipes, meal planning, food production, health, and nutrition; entertainment services, namely, conducting contests		

Attachments	73704031#TMSN.gif(bytes) 75506914#TMSN.gif(bytes) 76514923#TMSN.gif(bytes) 76978084#TMSN.gif(bytes) 78809764#TMSN.jpeg(bytes) 77539722#TMSN.jpeg(bytes) 85314321#TMSN.jpeg(bytes)
-------------	---

	78788724#TMSN.jpeg(bytes) 85311402#TMSN.jpeg(bytes) WFMV5597US1- Notice of Opposition WHOLEATS and Design.pdf(19607 bytes)
--	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/cl graff/
Name	Christopher L. Graff
Date	12/09/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In Re Serial No. 85/805,291	§	
Filed: December 18, 2012	§	
Mark: WHOLEATS (and Design)	§	Opposition No. _____
Published: June 11, 2013	§	
	§	
Whole Foods Market IP, L.P.,	§	
	§	
Opposer,	§	
v.	§	
	§	
Joseph Murdock,	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

Opposer Whole Foods Market IP, L.P., a limited partnership organized under the laws of the State of Delaware, having an address at 550 Bowie Street, 6th Floor, Austin, Texas 78703, and whose general partner is WFM IP Management, Inc., a Delaware corporation, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer is the owner of the well-known WHOLE FOODS mark, as well as a family of “WHOLE _____” marks, such as WHOLE FOODS MARKET, WHOLEZYME, WHOLE STORY, WHOLE BABY, WHOLE TRADE, THE WHOLE DEAL, THE WHOLE GROCER, WHOLE CATCH, and WHOLE FOODS WINE & SPIRITS (the “WHOLE Marks”), which have been used for several years in connection with an extremely successful chain of retail grocery stores, as well as a wide variety of goods and services, including in-store restaurant and bakery services.

2. Opposer’s use of its WHOLE Marks has been continuous and extensive.

3. Several of Opposer's WHOLE Marks have become famous for all purposes relevant to this proceeding, including within the meaning of 15 U.S.C. § 1125(c)(2)(A).

4. In addition to its extensive common-law rights, Opposer is the owner of numerous United States Trademark registrations and applications covering its WHOLE Marks. Opposer's registrations include, but are not limited to those listed below:

- WHOLE FOODS MARKET, U.S. Reg. 1,961,586, issued March 12, 1996;
- WHOLE FOODS MARKET (Stylized), U.S. Reg. No. 1,557,320, issued September 19, 1998;
- WHOLEZYME, U.S. Reg. No. 2,473,973, issued July 31, 2001;
- WHOLE BABY, U.S. Reg. No. 3,087,983, issued May 02, 2006;
- WHOLE CATCH, U.S. Reg. No. 3,104,557, issued June 13, 2006;
- THE WHOLE GROCER, U.S. Reg. No. 3,135,943, issued August 29, 2006;
- THE WHOLE DEAL, U.S. Reg. No. 3,674,229, issued August 25, 2009;
- WHOLE FOODS WINE & SPIRITS, U.S. Reg. No. 4,158,967, issued June 12, 2012.
- WHOLE TRADE, U.S. Reg. No. 3,593,120, issued March 29, 2009; and
- WHOLE STORY, U.S. Reg. No. 4,053,172, issued November 8, 2011.

Each registration listed above is valid and subsisting, and the first five registrations are incontestable pursuant to 15 U.S.C. § 1065.

5. Opposer has invested considerable effort and expense in promoting its WHOLE Marks, and the products and services offered under these marks, with the result that the purchasing public has come to know, rely upon, and recognize the products and services of Opposer by these WHOLE Marks. Opposer has established valuable goodwill in its WHOLE Marks.

6. Applicant Joseph Murdock is a United States citizen with an address of 1242 South Dudley Street, Lakewood, Colorado 80232. Applicant filed U.S. Serial No. 85/805,291 ("the Application") on December 18, 2013 for the mark WHOLEATS (& Design) ("Applicant's Mark"). The Application covers "restaurant services" in Class 43.

7. There is no issue as to Opposer's priority. Opposer's first use in commerce of its

WHOLE Marks precedes any date of first use of Applicant's Mark and the filing date of the Application.

8. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

9. Applicant's services are, upon information and belief, purchased and used by the same or similar types of consumers who purchase and use Opposer's goods and services.

10. Accordingly, Applicant's Mark so resembles Opposer's WHOLE Marks as to be likely, when used in connection with Applicant's identified services, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are familiar with Opposer's WHOLE Marks and are likely to mistakenly believe that the services Applicant intends to offer under Applicant's Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its WHOLE FOODS products and services. Registration should therefore be refused under 15 U.S.C. §§ 1052(d) and 1063.

11. Further, Applicant's Mark is likely to cause dilution by blurring of Opposer's famous WHOLE Marks, and registration should therefore also be refused under 15 U.S.C. § 1125(c).

Wherefore, Opposer prays that Application Serial No. 85/805,291 be rejected, and that registration of Applicant's Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.R. F. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/WFMV:5597/CLG, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: December 9, 2013

/s/ Christopher L. Graff
Christopher L. Graff
Jered E. Matthysse
PIRKEY BARBER PLLC
600 Congress Avenue, Suite 2120
Austin, TX 78701
Telephone: (512) 322-5200
ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served via First-Class Mail, postage pre-paid, on December 9, 2013 at the address of record for Applicant's correspondent of record:

Joseph Murdock
1242 South Dudley Street,
Lakewood, Colorado 80232

/s/ Christopher L. Graff